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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WASIQ MAHOOD BOKHARI, UMAIR AZIM KHAN,
ANNE SAJER KOHNEN, and QUINTON YVES ZONDERVAN

Appeal 2010-000568
Application 09/902,929
Technology Center 2100

Before HOWARD B. BLANKENSHIP, JEAN R. HOMERE, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-44, which are all the claims in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

DISCUSSION

Firepad Fireviewer Suite Installation Manual and User's Guide

In an order (mailed Nov. 30, 2007) remanding the proceeding to the Examiner, we noted that all of the pending claims were rejected under 35 U.S.C. § 103(a) based on evidence that included a printed copy of a document referenced as "Firepad Fireviewer Suite User's Guide." We determined that the record did not support the Examiner's allegation that the document was a reference under 35 U.S.C. § 102(b). We authorized the Examiner to prepare a supplemental examiner's answer for an explanation as to why the document should be considered to represent prior art, if the rejection was to be maintained.

After a time, the Examiner provided a new (i.e., not a supplemental) Answer that designated new grounds of rejection, because the rejections rely on new evidence (a screenshot) as support for the view that "Firepad" represents prior art.

Firstly, the examiner would again like to point out that the Fireviewer 6.0 Shareware Screenshot is provided to provide evidence that the software disclosed in the Firepad reference was publicly available prior to Appellant's filing date. As the Firepad reference teaches the use of FireViewer 6.0 (see pages 10, 12, 15), the examiner contends that the features disclosed therein were publicly available at least as early as 17 June 2001,

as disclosed in the Shareware Screenshot. Therefore, the examiner contends that the Firepad reference is valid prior art under 35 U.S.C. 102(a).

Examiner's Answer, Jun. 26, 2009, at 16-17.

Section 102(a)

Section 102(a) of Title 35 provides:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent

Section 102(a) thus contains two separate bases for patent-defeating lack of novelty: that the invention was “known or used by others in this country,” or “described in a printed publication in this or a foreign country,” before the invention thereof by the applicant.

The phrase “described in a printed publication in this or a foreign country,” by its terms, is limited to information contained in a single “printed publication.” “[K]nown or used by others in this country,” however, requires more than mere knowledge or use by others of the invention in this country. The knowledge or use must have been available to the public.

Section 102(a) establishes that a person can not patent what was already known to others. If the invention was known to or used by others in this country before the date of the patentee's invention, the later inventor has not contributed to the store of knowledge, and has no entitlement to a patent. Accordingly, in order to invalidate a patent based on prior knowledge or use, that knowledge or use must have been

available to the public. *See Carella v. Starlight Archery*, 804 F.2d 135, 139, 231 USPQ 644, 646 (Fed. Cir. 1986) (the Section 102(a) language “known or used by others in this country” means knowledge or use which is accessible to the public); 35 U.S.C. Section 102(a) reviser’s note (1952) (noting that “‘known’ has been held to mean ‘publicly known’” and that “no change in the language is made at this time”); P.J. Federico, *Commentary on the New Patent Act* (1954) reprinted in 75 J. Pat. Trademark Off. Soc’y 161, 178 (1993) (“interpretation [of Section 102(a)] by the courts excludes various kinds of private knowledge not known to the public”; these “narrowing interpretations are not changed”).

Woodland Trust v. Flowertree Nursery, Inc., 148 F.3d 1368, 1370 (Fed. Cir. 1998).

Analysis

The Examiner’s statements in support of why the “Fireviewer” manual should be considered to represent prior art under 35 U.S.C. § 102(a), which we reproduced *supra*, are not clear. The Examiner refers to the “Firepad reference” as if the manual is to be considered a “printed publication” in accordance with the statute. Yet, the Examiner also refers to the software “features” described in the Firepad manual being publicly available prior to the instant application filing date, which suggests that the manual is to be taken as evidence that the information in the manual was “known or used by others in this country” prior to the application filing date.

According to this record, the instant application filing date is July 10, 2001. The file copy of the “FireViewer Suite” manual contains a copyright notice (at 2) of 2001. As the Examiner seems to acknowledge, the manual

by itself does not indicate that the manual qualified as a “printed publication” prior to July 10, 2001.

The “screenshot” evidence shows that a shareware version of “FireViewer Suite 6.0” was uploaded to a shareware Web site (“The UK’s Premier Website for Shareware and Freeware Downloads”) on June 17, 2001, which predates filing of the instant application.

If we assume the “screenshot” evidence is submitted to demonstrate that the provided version of the FireViewer manual qualified as a “printed publication” prior to July 10, 2001, the evidence falls short. The Examiner’s rejections rely on some portions of the manual that speak of “Version 6.0” (e.g., at 15). However, the rejections also rely on portions that speak of version “6.x” (e.g., at 12). Moreover, a “printed publication” such as a software manual can be directed to discussion of earlier (or current) software versions, but published later than the initial availability of the earlier (or current) versions of the software.

If we assume the “screenshot” evidence is submitted to demonstrate that the software package itself (Version 6.0) was known or used by others in this country prior to July 10, 2001, the evidence also falls short. The “screenshot” suggests that a shareware version of the software was uploaded to a Web site, apparently, in the United Kingdom. There is no evidence provided that the shareware (or full) Version 6.0 was downloaded, or otherwise “known or used by others in this country,” prior to July 10, 2001. Moreover, there is no evidence provided to show that the “free trial version” available for download had features identical to those described in the provided FireViewer manual.

Thus, we conclude that the “FireViewer Suite” manual has not been shown to qualify as a “printed publication” prior to the critical date. Nor has the evidence established publicly accessible use or knowledge of the invention (i.e., the software features described in the manual) in this country prior to the critical date. On this record, too much speculation is required to reach a conclusion that the information in the “FireViewer” manual represents prior art under 35 U.S.C. § 102(a). We decline to engage in such speculation.

Conclusion

Accordingly, since all the rejections on appeal rely on the “FireViewer Suite” manual, we cannot sustain any of the § 103(a) rejections.

DECISION

The Examiner’s rejections of claims 1-44 under 35 U.S.C. § 103(a) are reversed.

REVERSED

msc

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